

Remarks:

Applicant has studied the Office Action dated 10/17/2005, and has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 1, 11 and 17 have been amended. No new matter has been added. Support for the new claims and the amendments is found in the original claims as filed, the specification and the drawings, particularly pages 9, 10 and 12 of the specification. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Claims 1, 2, 3, 5, 6 and 17-20 have been rejected under 35 U.S.C. 102 (b) as being unpatentable over U.S. Patent No. 6,463,300 to Oshima. Claims 4 and 7-10 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima in view of U.S. Patent No. 20040195313 A1 to Lee; and claims 11-16 as being unpatentable over Oshima in view of U.S. Patent No. 20040166839 A1 to Okkonen, et al.

§102 Rejection(s):

It is respectfully noted that anticipation of claims using a drawing requires that "the picture must show all the claimed structural features and how they are put together" and "[t]he drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art." M.P.E.P. §2125. Furthermore, anticipation of a claim under 35 U.S.C. §102 (a), (b) and (c) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" and "[t]he elements must be arranged as required by the claim." M.P.E.P. §2131.

Since the Oshima reference fails to disclose at least one of the recited elements in the amended claims, a rejection under § 102 would be improper. Particularly, Oshima fails to disclose that (1) the data structure is stored in an internal memory of the mobile communications module, and (2) the configuration data comprises network access information needed to allow the mobile device operate in the mobile communications network using the first identity module without need for externally programming the mobile device with the network access information.

The Examiner is invited to point out the above two elements with specificity, or otherwise withdraw the 102 rejection. *Please note that the above elements, in amended claim 1, were previously introduced in the original claims (e.g., see claims 11, 17 and 20) and should not be construed as newly introduced matter to justify a new search. Therefore, if a new search is performed or new grounds of rejection are issued, the next action cannot be made final.*

Independent claims 11 and 17, and dependent claims 2-10 and 16-20 substantially incorporate the elements of claim 1 and are therefore also distinguishable from the Oshima reference.

§103 Rejection(s):

The Examiner contends that it would have been obvious to combine the teachings of Oshima, Lee and Okkonen to implement the claimed invention. This rejection is respectfully traversed.

Referring back to the Oshima reference, Applicant submits that the claimed invention as recited in claim 1 is patently distinguishable from the device of Oshima, in that Oshima expressly teaches away from the present invention. Particularly, FIG. 3 and column 5, lines 37-38 of the reference disclose a table 252 that is included “in a SIM” (see also col. 7, lns. 35-45). The Examiner contends that table 252 is equivalent to the recited data structure in claim 1. The recited data structure in claim 1, however, is stored in an internal memory of the mobile device (rather than in a SIM as suggested by Oshima).

If the claimed data structure of the present invention was stored in the SIM, then the mobile device would not have access to the configuration data, stored in the data structure, when the SIM card is removed. In the present invention, the configuration data is stored in an internal memory of the mobile device, so that the configuration data can be accessed when the first SIM is removed and a new SIM is inserted in the mobile terminal. As such, Oshima’s teaching defeats the purpose of the invention because storing the configuration data in the first SIM card makes the configuration data no longer accessible after the first SIM card is removed from the mobile device.

Since, following Oshima’s suggestion would make the present invention inoperable, there is no motivation for a person of ordinary skill in the art to use Oshima in the direction of the claimed invention.

Furthermore, table 252 of Oshima is not used for storing “configuration data” that comprises “network access information needed to allow the mobile device operate in the mobile communications network,” as claimed in claim 1. The data stored in table 252 is a PIN number, according to Oshima, that is used to uniquely identify an authorized user of the mobile terminal, in case the mobile terminal is lost or stolen (see col. 9, lns. 55-59; col. 10, lns. 39-50; and background section). Thus, the Examiner has misconstrued the meaning of the data 254 stored in table 252. As a result, the Oshima reference cannot serve the intended purpose of the invention (i.e., storing configuration data to allow the mobile device to communicate in a mobile network), as claimed.

The Applicant submits that for the above reasons alone, it would be improper to suggest that a person of ordinary skill would be motivated to combine or modify any reference with Oshima in the direction of the present invention. Therefore, it is respectfully requested that 103 grounds of rejection to be withdrawn.

Furthermore, other cited references, namely Lee and Okkonen both fail to cure the deficiencies of Oshima. Curiously, Lee also teaches away from the claimed invention by emphasizing in paragraph [0030] that the “network set-up information” is to be stored in the smart card “instead of the flash memory” which is the internal memory of the mobile device (emphasis added.) See also FIGS. 1 and 4 of Lee.

Respectfully, when two references expressly teach away from the claimed invention, it would be unreasonable to suggest that the references in combination would teach the claimed invention, or even that there is a motivation for their combination. Furthermore, the applicant has carefully reviewed the references and submits that no portions of the cited references provide a suggestion or motivation for combining the references in a manner that would make the invention as recited in claims 1-20 obvious.

Since obviousness may not be established by hindsight reconstruction or conjecture, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

The Okkonen references suffers from the same deficiencies as provided above with respect to Oshima and Lee. Particularly, Okkonen suggests a system using a single “SIM card 123” in a “plurality of electronic devices 123 [sic]” (see par. [0041]). This is in direct contrast to the objective of the claimed invention as recited in claim 1, which is to facilitate the interchangeable use of plurality of SIM cards in a single mobile device, by storing configuration information for each SIM in the internal memory of the mobile device.

Okkonen is further distinguishable from the claimed invention in that it teaches away from storing configuration information in internal memory of the device by suggesting that such information is

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² “The rationale supporting an obviousness rejection may be based on common knowledge in the art or “well-known” prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner.”

provided remotely (i.e., “over-the-air”) by a “service coordinator” located in either a “manufacturer’s environment, a “carrier network”, a “service provider” or other “external source”. See paragraphs [0045] and [0061] of Okkonen. Since claim 1 as amended recites storing the configuration information in an internal source (i.e., internal memory) of the mobile device, Okkonen also teaches away from the claimed invention.

In light of the above deficiencies, there would be no motivation for combination of the cited references. Prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining the teachings.” In re Sernaker, 217 USPQ 1, 6 (Fed. Cir. 1983). Further, it is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

It is respectfully submitted that the cited prior art references cannot be combined to teach the claimed invention. Further, even if one is modified in accordance to the teaching of the other, the resultant modification would be an impractical or inoperable combination for the reasons discussed earlier.

Moreover, there is no indication in the Office Action, how combination of the cited references is possible, as the three systems are independently complex and cannot be easily modified to work with each other. Further, even if the systems can be combined, the resultant combination will not function to accomplish the intended purpose of the invention. Therefore, the cited references cannot be combined to teach the claimed invention.

“In rejecting claims under 35 U.S.C. §103, the examiner bears the initial burden of presenting a prima facie case of obviousness. ‘A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.’ In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The cited references, neither alone nor in combination, teach or describe the claimed invention, as amended.

That is, neither Oshima, nor Lee, nor Okkonen teach or disclose “A method of configuring a mobile device in a mobile communications network, the method comprising: determining whether a first identity module coupled to a mobile device is different from a second identity module previously coupled to the mobile device; searching entries in a data structure for first configuration data associated with the

first identity module; and configuring the mobile device to use the first configuration data, when said first configuration data is present in an entry of the data structure, wherein the data structure is stored in an internal memory of the mobile communications module and the data structure comprises a plurality of entries that comprise configuration data for respective plurality of identity modules that can be coupled to the mobile device, and wherein the configuration data comprises network access information needed to allow the mobile device operate in the mobile communications network using the first identity module without need for externally programming the mobile device with the network access information.”

For the above reasons, the invention as recited in the amended claim 1 is patentably distinguishable over the references cited by the Examiner. Claims 11 and 17 substantially incorporate the discussed limitations of claim 1 and therefore independent claims 1, 11 and 17 should be in condition for allowance. Claims 2-10, 12-16 and 18-20, respectively depending on claims 1, 11 and 17 should also be also in condition for allowance by the virtue of their dependence on allowable base claims.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number [310] 789 2100 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,



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